

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dipan D. Patel Art Unit : 2454
Patent No. : 8,015,267 Examiner : James T. Baron
Issue Date : September 6, 2011 Conf. No. : 6357
Serial No. : 10/561,428
Filed : March 26, 2007
Title : METHOD AND SYSTEM FOR SELECTIVELY DISTRIBUTING DATA TO A
SET OF NETWORK DEVICES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 658 days to 838 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentee respectfully submits that the Office did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

A reply to an Office Action was due on or before May 26, 2009 (the date that is three months after February 25, 2009, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on June 19, 2009. Patentee was accorded a delay of 25 days for a late response. Patentee respectfully submits that the PTO calculated delay from May 25, 2009,

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November 3, 2011

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Applicant : Dipankumar D. Patel
Patent No. : 8,015,267
Issued : September 6, 2011
Serial No. : 10/561,428
Filed : March 26, 2007
Page : 2 of 6

Attorney's Docket No.: 12587-0266US1 / A 6146US-hy

instead of May 26, 2009. As intended in 35 U.S.C. § 154(b)(2)(C)(ii), the three-month due date should be calculated from May 26, 2009, as May 25, 2009, falls over a weekend, and Patentee requests that the Office recalculate this period of Applicant Delay as 24 days, for delay from May 27, 2009, to June 19, 2009. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before February 12, 2010 (the date that is three months after November 12, 2009, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on March 11, 2010, thereby according an Applicant Delay of 27 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from February 13, 2010 (the day after the date that is three months after the date on which the Office Action was mailed), to March 11, 2010. See 37 C.F.R. § 1.704(b).

A Notice of Non-Compliant Amendment was mailed by the PTO on June 10, 2010, subsequent to a response filed by Patentee on March 11, 2010. Patentee filed a response to the Notice of Non-Compliant Amendment on July 8, 2010, thereby according an Applicant Delay of 119 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from March 12, 2010, to July 8, 2010. See 37 C.F.R. § 1.704(c)(7).

A reply to an Office Action was due on or before December 3, 2010 (the date that is three months after September 3, 2010, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on December 30, 2010, thereby according an Applicant Delay of 27 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from December 4, 2010 (the day after the date that is three months after the date on which the Office Action was mailed), to December 30, 2010. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on May 23, 2011, subsequent to the mailing of the Notice of Allowance. The PTO mailed a response to the Information Disclosure Statement on June 9, 2011. Patentee was accorded a delay of 17 days for this post-allowance filing. Patentee does not dispute the PTO's calculation for this Applicant Delay from May 23, 2011, to June 9, 2011. See 37 C.F.R. § 1.704(c)(10).

Patentee filed an Information Disclosure Statement on June 9, 2011, subsequent to the mailing of the Notice of Allowance. The PTO mailed a response to the Information Disclosure

Applicant : Dipankumar D. Patel
Patent No. : 8,015,267
Issued : September 6, 2011
Serial No. : 10/561,428
Filed : March 26, 2007
Page : 3 of 6

Attorney's Docket No.: 12587-0266US1 / A 6146US-hy

Statement on June 29, 2011. Patentee was accorded 1 day delay for a post-allowance filing. In good faith and candor, Patentee submits that the post-allowance filing should have been accorded a total Applicant Delay of 21 days for delay from June 9, 2011, to June 29, 2011.

See 37 C.F.R. § 1.704(c)(10).

Patentee filed an Amendment Pursuant to 37 C.F.R. § 1.312 on July 6, 2011, subsequent to the mailing of the Notice of Allowance. The PTO mailed a response to the Amendment Pursuant to 37 C.F.R. § 1.312 on July 18, 2011. Patentee was accorded a delay of 63 days for this post-allowance filing. Patentee respectfully submits that a period of 13 days is appropriate for delay under 37 C.F.R. § 1.704(c)(10), from July 6, 2011, to July 18, 2011, and asks that the Office recalculate this period of Applicant Delay as 13 days. See 37 C.F.R. § 1.704(c)(10).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 248 days (i.e., the sum of 24 days, 27 days, 119 days, 27 days, 17 days, 21 days, and 13 days).

“A Delay”

A first PTO action was due on or before May 26, 2008 (the date that is fourteen months after March 26, 2007, the date on which the application fulfilled the requirements of 35 U.S.C. § 371). The PTO mailed the first non-final Office Action on December 9, 2008, thereby according a PTO Delay of 197 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from May 27, 2008 (the day after the date that is fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. § 371), to December 9, 2008.

See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before October 19, 2009 (the date that is four months after June 19, 2009, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on November 12, 2009, thereby according a PTO Delay of 24 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from October 20, 2009 (the day after the date that is four months after the date on which a response to Office Action was filed), to November 12, 2009. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

Applicant : Dipankumar D. Patel
Patent No. : 8,015,267
Issued : September 6, 2011
Serial No. : 10/561,428
Filed : March 26, 2007
Page : 4 of 6

Attorney's Docket No.: 12587-0266US1 / A 6146US-hy

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 221 days (i.e., the sum of 197 days and 24 days).

“B Delay”

The present application is a national stage filing under 35 U.S.C. § 371 of international application number PCT/GB2004/002570, filed June 16, 2004, which claims the benefit of priority of Great Britain provisional application number 0314043.1, filed June 17, 2003.

The national stage for the present application “commenced” under the provisions of 35 U.S.C. § 371(b), i.e., upon expiration of 30 months from the priority date of the international application.¹ As a result, the date that the national stage commenced was December 19, 2005 (i.e., 30 months from the priority date of June 17, 2003).

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentee is entitled to “B Delay” to compensate for that Office delay. The only issue in contention is the correct length of the “B Delay” period.

The period beginning on December 20, 2008 (the day after the date that is three years after the date on which the national stage commenced), and ending September 6, 2011 (the date the patent was issued), is 991 days in length. The “PTA 36 Months” entry in the PAIR/PALM system indicates that a total of 740 days were awarded for “B Delay” for this patent. Patentee respectfully submits that the PTO’s calculation of this “B Delay” is incorrect.

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of “B Delay” “any time consumed by continued examination of the application.” In the present matter, a Request for Continued Examination was filed on December 30, 2010. The Director erred in the calculation of patent term adjustment by subtracting from “B Delay” a period of time that was not “consumed by continued examination of the application.” The PTO mailed a Notice of Allowance on April 11, 2011, thereby closing examination of the application on that date. Thus, no continued examination took place during the 142 day period from April 11, 2011 (the mailing date of the Notice of Allowance), until September 6, 2011 (the date the patent was issued). Accordingly, 149 days of “B Delay” should have been included in addition to the 740 days

¹ A complete request for early processing under 35 U.S.C. § 371(f) was not filed with the present application.

Applicant : Dipankumar D. Patel
Patent No. : 8,015,267
Issued : September 6, 2011
Serial No. : 10/561,428
Filed : March 26, 2007
Page : 5 of 6

Attorney's Docket No.: 12587-0266US1 / A 6146US-hy

accorded by the Director, for a total “B Delay” of 889 days. Patentee respectfully submits that the Office’s calculation of “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 889 days.

Overlap of “A Delay” and “B Delay”

As detailed above, 221 days of “A Delay” accumulated during the following periods:

May 27, 2008, to December 9, 2008; and

October 20, 2009, to November 12, 2009.

As detailed above, 889 days of “B Delay” accumulated during the following periods:

December 20, 2008, to December 30, 2010; and

April 11, 2011, to September 6, 2011.

As such, the periods of “A Delay” and “B Delay” overlap (i.e., occur on the same calendar day) for a total of 24 days, from October 20, 2009, to November 12, 2009.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 658 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,086 days (i.e., the sum of 221 days of “A Delay” and 889 days of “B Delay” minus 24 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 248 days; and
- 3) Total PTA should be calculated as 838 days.

Applicant : Dipankumar D. Patel
Patent No. : 8,015,267
Issued : September 6, 2011
Serial No. : 10/561,428
Filed : March 26, 2007
Page : 6 of 6

Attorney's Docket No.: 12587-0266US1 / A 6146US-hy

The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 12587-0266US1.

Respectfully submitted,

Date: November 3, 2011

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